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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,398	09/28/2001	Jess Baker	BS01-231	5490

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Withers & Keys LLC
PO Box 71355
Marietta, GA 30007-1355

EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,398

Applicant(s)

BAKER ET AL.

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004 and 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


JACK/CHIANG
PRIMARY EXAMINER

CLAIMS

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madsen et al. (US 6174205) in view of Corning (SRP-202-296).

Regarding claim 1, Madsen shows a telephone (col. 1, lines 11-14, col. 3, lines 39-47) comprising:

A housing (i.e. 14, col. 1, lines 11-14, col. 3, lines 39-47);

POTS circuitry (inside 14, col. 1, lines 11-14, col. 3, lines 39-47);

a location (PCMCIA slot) within the housing (i.e. 14) adapted to engage a filter cartridge (in 52), the location including an electrical connector (col. 8, lines 8-11) for the POTS circuitry;

a cartridge (52) adapted to be inserted into the location and including a first (56) and second (72) end, the first end (56) being inserted into the location (PCMCIA slot);

the first end (56) including at least one connector (col. 8, lines 8-11) for the POTS circuitry;

the second end (72) including at least one first connector for receiving a DSL line, and at least one second connector for receiving a phone line (see, 114, 116, 118, col. 9, lines 54-63; col. 10, lines 1-10);

the second end (72) is configured to accept the DSL line and the phone line simultaneously (claim 9 in Madsen).

Madsen differs from the claimed invention in that it does not explicitly mention that the cartridge receives a signal containing both DSL and POTS signals and filters these signals.

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However, Madsen's device is connected to the phone line (12 in fig. 1, col. 1, lines 11-14, col. 3, lines 39-47) which usually receive POTS signals, and also allows DSL connection (col. 10, lines 1-10). Further, Corning teaches providing a cartridge (3) having a first connector (5) for the POTS circuitry (10), and receiving (6) a signal containing both DSL (4) and POTS (5, 9) signals and filters these signals, and simultaneously pass the DSL (4) signal and the POTS (5, 9) signals to their respectively connectors.

Hence, if it is found that Madsen does not have the capacity of filtering the DSL and POTS signals, then it would have been obvious for one of ordinary skill in the art to modify Madsen with the filtering as taught by Corning, such that to allow the device to process Voice and Data simultaneously (see DESCRIPTION in Corning).

Regarding claim 7, Madsen shows a cartridge (in 52) for a telephone (col. 3, lines 39-47) comprising:

a first and second end (56, 72), the first end being adapted to be inserted into a location within a housing of the telephone (i.e. 14, col. 1, lines 11-14, col. 3, lines 39-47);

the first end (56) including at least one connector (col. 8, lines 8-11) for the POTS circuitry (i.e. 14, col. 1, lines 11-14, col. 3, lines 39-47);

the second end (7) including at least one DSL connector for receiving a DSL line, and at least one second connector for receiving a phone line (see, 114, 116, 118, col. 9, lines 54-63, col. 10, lines 1-10);

the second end (72) is configured to accept the DSL line and the phone line simultaneously (claim 9 in Madsen).

Madsen differs from the claimed invention in that it does not explicitly mention that the cartridge receives a signal containing both DSL and POTS signals and filters these signals.

However, Madsen's device is connected to the phone line (12 in fig. 1, col. 1, lines 11-14, col. 3, lines 39-47) which usually receive POTS signals, and also allows DSL connection (col. 10, lines 1-10). Further, Corning teaches providing a cartridge (3) having a first connector (5) for the POTS circuitry (10), and receiving (6) a signal containing both DSL (4) and POTS (5, 9) signals and filters these signals, and simultaneously pass the DSL (4) signal and the POTS (5, 9) signals to their respectively connectors.

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Hence, if it is found that Madsen does not have the capacity of filtering the DSL and POTS signals, then it would have been obvious for one of ordinary skill in the art to modify Madsen with the filtering as taught by Corning, such that to allow the device to process Voice and Data simultaneously (see DESCRIPTION in Corning).

Regarding claim 11, Madsen shows a cartridge (in 52) for a telephone (col. 3, lines 39-47) comprising:

a first and second end (56, 72), the first end being adapted to be inserted into a location within a housing of the telephone (i.e. 14, col. 1, lines 11-14, col. 3, lines 39-47);

the first end (56) including at least one connector (col. 8, lines 8-11) for the POTS circuitry (i.e. 14, col. 1, lines 11-14, col. 3, lines 39-47);

the second end (56) including at least one line connector for receiving a phone line and a DSL connector for receiving a DSL line (see, 114, 116, 118, col. 9, lines 54-63, col. 10, lines 1-10),

the removable cartridge (52); and

the second end (72) is configured to accept the DSL line and the phone line simultaneously (claim 9 in Madsen).

Madsen differs from the claimed invention in that it does not explicitly mention about splitting the DSL and POTS signals.

However, in interface card which involves the combination of DSL line and PSTN line, it is commonly seen that signals are split. This is also shown by Corning, in which the signals are split (see filtering in DESCRIPTION).

Hence, if it is found that Madsen's signals are not split in the design of the interface card, it would have been obvious for one of ordinary skill in the art to adapt Corning's interface design in Madsen, this type of design is considered conventional when such card are needed to interface with the PSTN and the DSL systems (see DESCRIPTION in Corning).

Regarding claims 2-5, 8-10, 12-19, the combination of Madsen and Corning shows:

a DSL filter (DESCRIPTION in Corning; see also col. 10, lines 1-10 in Madsen);

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the removable filter cartridge (52 in Madsen) where the ejection feature/switch is common when cartridge is used (the PCMCIA latching design is conventional and admitted prior art in page 9, bottom paragraph of the present application);

the female connector (see 114, 116, 118);

the four conductors or first inner pair and second outer pair (such as 4, 5, 9 in Corning);

further, when cartridge is retained, it usually has biasing latch and shoulder to hold the cartridge, these are conventional features in holding and ejecting a cartridge, including the three position switch (the PCMCIA latching design is conventional and admitted prior art in page 9, bottom paragraph of the present application).

NOTE: numerals are added into various figures in Corning by the Examiner.

ARGUMENT

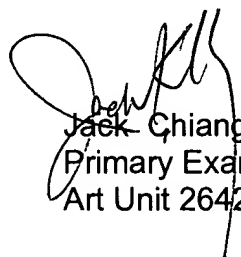
3. In response to the remarks (pages 6-9), applicant mainly argues that Madsen does not receive the DSL and POTS signals, the filtering ... upstream. The examiner disagrees. First, in the environment of Madsen, the device is directly connected to the phone line (12 in fig. 1), the filter is most likely inside the cartridge, not any upstream filtering. This is also taught by Corning, see rejection above.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
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